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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/834,059	04/12/01	WEI Y	514-039-11

004955 QM12/1015
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EXAMINER
FOSTER, J

ART UNIT	PAPER NUMBER
3728	4

DATE MAILED: 10/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/834,059

Applicant(s)

Wei

Examiner

Jimmy G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-16 is/are rejected.
- 7) ☒ Claim(s) 2-7 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification as originally filed fails to support the invention as is now claimed in claims 9-16. The new matter claimed is the "at least one sliding plate" (claim 9). The original disclosure did not consider, suggest or disclose the use of only one sliding plate for connection to the receiving members. Throughout the original disclosure it is consistently disclosed that two sliding plates connect the receiving members to each other and connect the receiving members to the actuating member (which is itself an inherent receiving member). New

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matter may exist by virtue of the omission of a feature. See United States Industrial Chemicals, Inc v. Carbide and Carbon Chemicals Corp., 315 US 668, 53 USPQ 6 (1942). Also see MPEP 1411.02. In addition, it has been held that claims may be made no broader than the supporting original disclosure. The Gentry Gallery Inc v. The Berkline Corp., 45 USPQ2d 1498 (Fed. Cir. 1998).

2. Claims 9-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Bond (5,609,322). The utility jack 1 of Bond is disclosed as being for holding paint tools. It includes a mainframe/base portion 3 that has side walls 24,24. In the orientation of the utility jack on a slanted roof, as shown in Figure 1 (also see Figure 2), the bottom of the cavities 7,8 defines a back wall. In the same orientation, the wall to which frame 12 is pivotally attached constitutes a top, and the wall opposite the top constitutes a bottom. Within the base portion 3 are movable brackets 16 that define sliding plates. The sliding plates 16 slide with respect to the side walls 24,24.

The combination of frame 12 with tray 29 defines a receiving member since the combination has a recess 30 to receive articles, such as paint tools. This receiving member combination is pivotally connected to the top and between the side walls 24,24. Another frame and tray combination is provided at 36,39 to define a second receiving member. This combination receiving member is pivotally connected to the partition flange 9 (see Figure 2).

When the receiving members are retracted within the base portion 30, the sliding plates 16 are pivotally connected to a receiving member 12,39 -- to the frame portion -- at a position that is to the rear of the location of the pivotal connection (e.g. 15) between the receiving member and the base portion.

5. Claims 9-12, 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Vasudeva (5,803,254). Main box portion 1 and lid 3 of the tool case of Vasudeva defines a base portion.

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In the orientation shown in Figures 7 and 8, the base portion includes a top (where the handle is), a bottom (nearest the "FIG.7" or "FIG.8" designation, and a back wall (on the right side of the figure). The side walls of the base portion will be parallel to the view in Figures 7 and 8. Within the base portion, storage containers 16 are pivotally connected/mounted to the side walls at the connection of the pins 25 with the female connection means 26. The storage containers 16 are also pivotally connected/mounted to the slidable plates/gang bars 30, wherein the male connections 31 engage the female openings 32. The slidable plates slide over/with respect to the side walls of the base portion. When this happens, the receiving member containers pivot as a group toward an open position or toward a closed position. See the difference between Figures 7 and 8.

Any one of the receiving member containers 16 is capable of being manually manipulated to pivot that container and therefore the other containers at the same time. Accordingly, any one of the containers may also be considered to reasonably define an actuating member since it can be used to actuate the other containers.

As shown in Figure 9, a centrally located wall/separating board (unnumbered) is provided, such that the separating board separates the receptacle portion that holds the six receiving member containers 16, from the remainder of the container which includes the storage section dividers 45. A portion of the separating board includes the interior slot projections 46, which may be considered to be considered to include a portion at a greater distance away from the other side wall (on the side of

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the receiving container receptacle) than the remainder of the separating board.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bond (5,609,322) in view of Sidabras et al (5,570,784). The reference of Sidabras et al at 42 and at Figure 1 suggests that a tool receiving member may be provided with plural recesses for the purpose of positioning the tools in an orderly manner. Accordingly, it would have been obvious in view of Sidabras et al to have provided the receiving member 12,29 of Bond with plural recesses for the purpose of positioning tools in an orderly manner.

8. Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bond (5,803,254) in view of Sidabras et al (5,570,784). The reference of Sidabras et al at 42 and at Figure 1 suggests that a tool receiving member may be provided with plural recesses for the purpose of positioning the tools in an orderly manner. Accordingly, it would have been obvious in

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view of Sidabras et al to have provided the receiving members 16 of Vasudeva each with plural recesses for the purpose of positioning tools in an orderly manner in the receiving members.

9. Claims 9, 10 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Loomis (841,551). The cover/base portion 1 of Loomis, includes boxes/receiving members 4 (also called trays) pivotally attached to the base portion 1 at locations 5 and includes straps/sliding plates 8 which are pivotally attached to the ends of the receiving members 4 but which are slidably movable with respect to the side walls (unnumbered but shown in Figures 1,2). The connection of the sliding plates 8 with receiving members causes the receiving members to pivot together relative to the base portion.

In each receiving member 4 are wires 4', 4'', 4³ which effectively divide the receiving member into recesses. Compare Figures 2 and 4. Also see page 1 lines 64-68.

Although the device of Loomis is intended to display seeds, it is inherently capable of holding any tools that would have an appropriate size -- smaller than the recesses of the receiving members. This capability meets Applicant's functional limitation, "tool box".

10. Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. For contacting the PTO by phone, the following contact numbers may be used:

For tracking of papers and association of papers with cases --
Customer Service. . . (703)306-5648

For matters regarding examination -- Examiner:

Jim Foster (703)308-1505

For faxing of correspondence:

Draft amendments only-(703)308-7769

(Examiner should be notified of fax)

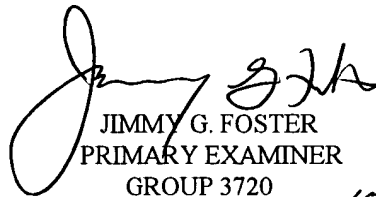
Formal correspondence-(703)305-3579 or 305-3580

For petitions:

Before the Examiner . (703)308-1505

Before the Director . (703)308-3872

Other petitions . . . (703)305-9282


JIMMY G. FOSTER
PRIMARY EXAMINER
GROUP 3720

10/9/01

JGF
October 9, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.